

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM J. JOHNSON and MICHAEL D. SMITH

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Appeal No. 95-4377  
Application 08/160,348<sup>1</sup>

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ON BRIEF

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Before MARTIN, BARRETT and FLEMING, Administrative Patent Judges.  
MARTIN, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 and 7, all of appellants' pending claims, under § 103. We reverse.

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<sup>1</sup> Application for patent filed December 1, 1993.

The invention relates to a data processing system which a cursor is used to select displayed objects (e.g., icons) and more particularly to altering the appearance of the cursor to indicate that a predefined process has been selected which is thereafter to be applied to the selected object or objects. Appellant treats both claims as standing or falling together (Brief at 4). Claim 1 reads as follows:

1. A graphic method for efficient execution of a predefined process within a data processing system having a keyboard, a plurality of objects and a movable cursor displayed therein, said method comprising the steps of:

specifying a predefined process within said data processing system, said predefined process comprising a plurality of keystrokes, said plurality of keystrokes specifying a user defined executable process which may be applied to one or more objects within said data processing system;

associating said predefined process with said movable cursor within said data processing system;

altering a graphic appearance of said movable cursor in response to said association of said predefined process with said movable cursor; and

executing said predefined process on a particular object within said data processing system in response to a graphic selection of said particular object by a user utilizing said movable cursor.

Both claims stand rejected under 35 U.S.C. § 112, second paragraph, and also under § 103 as unpatentable for obviousness over the following reference:

Cowart                    "Mastering Windows™ 3.1"                    1993<sup>2</sup>

A. The § 112 rejection

The examiner contends that the terms "may be" and "one or more" in the phrase "may be applied to one or more objects" render each claim indefinite:<sup>3</sup>

"[M]ay be" is indefinite since it includes the meaning of *may not be*. "[O]ne or more" is indefinite since it appears that a process defined for the execution of one object may not be used for more than one object. [Examiner's emphasis.] [Final Office action at 2.]

We agree with Appellants that while it is true that a process which is predefined for execution with only one object may not be used with another object, it is also true that a process which is

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<sup>2</sup> The Answer additionally cites, as "technical background," the following two articles: Tempo II, the Next Step in Macintosh Automation, Affinity Microsystems, Ltd., 1988, pp. 1-117 (of which only pages 33-117 are in the application file); and Takada et al., A Method of Generating User-Desired Service Macro in an Icon-Based Environment, 8169 Systems & Computers in Japan 19 (1988), sec. 5.5. Since these articles are not relied on the rejection, they have not been considered. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); Ex parte Movva, 31 USPQ2d 1027, 1028 n.1 (Bd. Pat. App. & Int. 1993).

<sup>3</sup> The examiner's criticism of the term "which" (final Office action at 2) is not repeated in the Answer and is therefore treated as withdrawn.

predefined for use with an (i.e., any) object can be used with more than one object. The fact that the claims are broad enough to encompass both types of processes does not render them indefinite. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971) (breadth should not be confused with indefiniteness). As a result, we do not agree with the examiner's contention (Answer at 5) that it is unclear which of the following conditions (a) to (f) is covered by the claims for the example of a macro A and objects B and C:

- (a) macro A is applicable to B or C;
- (b) macro A is applicable to B but not C;
- (c) macro A is applicable to C but not B;
- (d) macro A is not applicable to B or C;
- (e) macro A is applicable to both B and C at the same time;

and

(f) macro A is not applicable to both B and C at the same time.

The fact that the claims recite the step of, or means for, "executing said predefined process on a particular object" makes it clear that the predefined process A is executable with at least one of the objects B and C, thereby ruling out condition

(d). Each of the remaining conditions is possible, depending on the details of the predefined process.

B. The § 103 rejection

Cowart describes the features of the Windows™ 3.1 operating system. The features on which the examiner relies (Answer at 5-6) as evidence of obviousness are: defining macros (at 421-23); assigning an icon to a macro (at 741); using a cursor to select a macro or object (at 424); changing the cursor shape (at 834); using a macro to run another macro (at 427); and running a macro in one or more applications (at 425). The examiner contends that "it is within the level of skill of one or ordinary skill in the art to create macros representing standard functions such as Print, Cut, Copy, Paste, Open, etc... Such macros can be used as universal macros." Thus, he continues, "the combined teaching of assigning icons to macros, selecting icons with [a] cursor, and running a macro by another macro or running an application by a macro suggests that a user may define [a] universal macro, such as [an] OPEN macro, assign[] the OPEN macro with a[n] OPEN macro icon, select[] the OPEN macro icon to run another macro icon or object" (Answer at 6). Furthermore,

changing cursor appearance is well known, and is disclosed by Cowart on pages 834-836. It is well known to change the cursor's appearance to indicate the state or function being performed on the computer. Changing of the cursor

appearance in response to the associating of the cursor with a macro is also to indicate a state of computer operation. Thus it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to change the appearance of the cursor in response to . . . associating the cursor with a macro to indicate the state of operation. [Answer at 6-7.]

Appellants do not dispute that Cowart discloses using a macro to create a predefined process consisting of a plurality of keystrokes. However, they argue, and we agree, that Cowart does not disclose or suggest that a macro can be initiated on an object in response to selection of that object by a movable cursor. Instead, it discloses (at 424, 741) initiating a macro in any of the following ways: (a) opening the Recorder window and double-clicking on the macro to be run; (b) highlight the macro and then choosing Macro, Run; (c) pressing the shortcut key (e.g., Ctr + P) from any location; and (d) clicking on a icon associated with the macro. None of these techniques involves associating the macro with the cursor such that selection of an object by the cursor causes the macro to be performed on or in that object.

Appellants also correctly note that Cowart does not disclose or suggest changing the appearance of the cursor to represent selection of predefined process. Instead, Cowart (at 835-36) describes various programs for changing the appearance of the cursors to make them easier to locate on the screen: "BCursor," which doubles the cursor's size and making it solid rather than hollow; "ChngCrshr," which modifies the look and/or size of both the hourglass and pointer cursors; "Microsoft Mouse Driver 8.1," which sets the acceleration speed, horizontal and vertical sensitivity control, color, and size of the mouse pointer, including making the size of the pointer increase in size as it is moved; and "Cursorific!," which permits modification of the look, shape, and size of all the Windows cursors, with some of the available styles being shown in Figure 21.14, at 836.

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For the foregoing reasons, the rejection of claims 1 and 7 under 35 U.S.C. § 103 as unpatentable for obviousness over Cowart is reversed.

**REVERSED**

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JOHN C. MARTIN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LEE E. BARRETT	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
	)	
MICHAEL R. FLEMING	)	
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